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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,173	03/09/2001	Chong Seng Cheng	1601457-0004	9334
7470	7590	05/24/2010		
WHITE & CASE LLP PATENT DEPARTMENT 1155 AVENUE OF THE AMERICAS NEW YORK, NY 10036			EXAMINER BRAGDON, REGINALD GLENWOOD	
			ART UNIT	PAPER NUMBER
			2189	
			MAIL DATE	DELIVERY MODE
			05/24/2010	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHONG SENG CHENG

Appeal 2008-006002
Application 09/803,173
Technology Center 2100

Decided: May 24, 2010

Before HOWARD B. BLANKENSHIP, JEAN R. HOMERE, and
JAY P. LUCAS, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant's Request for Rehearing (filed Jan. 20, 2010) contends that we erred in our Decision on Appeal entered November 20, 2009 ("Decision"), in which we affirmed the Examiner's decision to reject claims 22-30.

DISCUSSION

Appellant does not request that we reconsider our finding that the Specification provides written description (35 U.S.C. § 112, first para.) support for the claim 22 recitation of “a non-volatile solid-state memory . . . having sufficient capacity to enable the unitary portable storage device to serve as an alternative to a magnetic disk or CD.” Rather, Appellant submits that we misapprehended the above-quoted limitation when comparing claim 22 to the applied prior art but not when finding the limitation to be supported by the Specification.

For the reasons set forth at pages 7 and 8 of the Decision, we concluded that, in light of the Specification, the “sufficient capacity” recitation did not require some minimum but undefined amount of memory as alleged by Appellant.

Appellant’s Request places a number (or numbers) on the *size* of memory that should be considered “sufficient capacity.” In particular, Appellant now alleges, without citation to anything in the record, that at the time of invention it was known in the art that some unidentified (“a”) magnetic disk or CD had at least about a megabyte of “capacity.” Appellant somehow concludes that the allegation places a “lower limit,” in the “claimed invention,” of an amount that is 440 bytes greater than one thousand bytes (i.e., 1.44 megabytes). Req. Reh’g 6.¹ Further, Appellant

¹ Appellant in the Request does not rely on the declaration evidence that we considered in the Decision. In any event, since it was Appellant’s burden to show that the Examiner erred in rejecting the claims, we considered the declarations only to the extent that the evidence was relied upon in the briefs.

fails to point out where the disclosure states or otherwise indicates that the invention was “designed to replace” the 1.44 MB floppy disk. *See id.*, n.2.

Even if we were to postulate that, however unlikely, all magnetic disks and all CD’s known to one of ordinary skill in the art at the time of invention contained at least one (or 1.44) megabytes of memory, there has been no showing that claim 22 requires the unproven minimum amount of memory that all existing magnetic disks or existing CD’s contained. In light of the Specification, the “sufficient capacity” of claim 22 does not require that the memory capacity of the data storage device equal or nearly equal one (or 1.44) megabyte.

Appellant also points to teachings in the Specification in which the flash memory in the data storage device may store software for installation on a computer, and submits that “most, if not all” of such software comprised more than one byte or one bit of data. *Id.* at 7. We did not, however, overlook or misapprehend the teachings of the Specification, but simply declined to read particular disclosed embodiments into the claims. Moreover, claim 22 could be read as covering a portable data storage device “capable of storing software for installation to the computer,” as recited in the preamble, but is not limited to a device capable of “storing software.” The claim preamble contains the alternative recitation of being capable of “receiving and storing user’s data present in the computer.”

Appellant has yet to point out where the word “capacity” may be defined, discussed, or even make an appearance in the Specification. “Capacity” may be defined as the maximum amount that can be contained. *See The American Heritage Dictionary, Second College Ed.* (1982) at 236 (“2. The maximum amount that can be contained: *a trunk filled to*

capacity.”). “Capacity,” however, can also be defined as “[t]he ability to receive, hold, or absorb.” *Id.*, def’n 1.a. Because the Specification did not define or indicate some required minimum amount of memory capacity to enable the portable data storage device to serve as “an alternative to a magnetic disk or CD,” we are not persuaded that the broadest reasonable interpretation of “sufficient capacity” as used in claim 22 is limited to mean an *amount* of memory equal to or greater than 1.44 (or one) megabytes. As we further indicated in the Decision, even if “sufficient capacity” were limited to “sufficient *memory* capacity” -- size or amount of memory -- there was insufficient evidence that the amount was limited to something more than one or a few bytes (i.e., capable of serving as a portable repository for data), or at the extreme required more memory information content than that which can be provided by a single bit.

Appellant’s Request also reargues the applied references, and in particular Gilbert, since Gilbert discloses a memory “capacity” even under Appellant’s unduly restrictive reading of “sufficient capacity.” Appellant submits that we “misapprehended the disclosure of the Gilbert reference” because the contents of the memory cannot be modified. Req. Reh’g 2.

However, as we indicated in the Decision (at 9), Gilbert discloses that the PDAC (card) can include non-volatile solid-state memory that contains software applications and user data. We did not misapprehend the disclosure of the Gilbert reference. Appellant’s arguments based on the PDAC containing only non-alterable EPROM are not persuasive. Moreover, even within a Gilbert paragraph to which Appellant refers (col. 3, ll. 37-53), the reference describes multiple embodiments of *alterable* non-volatile solid-state memory for storing software applications in addition to the

“preferred” EPROM embodiment. Finally, we observe that Appellant is reading yet more unfounded limitations into claim 22. Claim 22 does not distinguish over “non-alterable EPROM,” since the claim as broadly drafted reads on write-once non-volatile solid-state memory such as EPROM, which serves as an alternative to non-alterable compact discs.

We have reconsidered our interpretation of the disputed language of claim 22 in light of Appellant’s remarks in the Request. We have not considered Appellant’s new arguments (or re-arguments) concerning the references in the Request because Appellant does not point out where the arguments were presented in the briefs. The purpose of a Request for Rehearing is to bring to our attention what we might have misapprehended or overlooked in making our determinations (*see* 37 C.F.R. § 41.52(a)(1)), not for presenting arguments that could have been made in the briefs or re-arguing those that were made.

Appellant does, however, respond to our findings in the Decision (at 16) that the plug device described by Margalit can store confidential medical information, and thus Margalit discloses or at the least suggests a memory “capacity” within Appellant’s argued meaning of the term. Appellant argues that Margalit does not “disclose” that the confidential medical information is stored in a “non-volatile solid state memory” in the plug device. Req. Reh’g 15-16. Appellant neglects, however, to allege where the persistent confidential medical information may be stored in the plug device if not in “non-volatile solid state memory.” Moreover, as made clear in the Examiner’s rejection and in the Decision, claim 29 was rejected for obviousness under 35 U.S.C. § 103(a), rather than for anticipation under § 102. Even if Margalit were deemed to not describe (e.g., by express

terms) the storage of confidential medical information in non-volatile solid state memory, Appellant's argument is not persuasive in the context of the rejection of claim 29 under § 103(a) over Margalit and Jha.

DECISION

In summary, we have granted Appellant's request for rehearing to the extent that we have reconsidered our decision affirming the rejection of claims 22-30, but we decline to modify the decision in any way.

DENIED

msc

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